

REMARKS

Claims 1-14, 16-29, and 31-42 are pending.

In view of the following remarks, Applicants respectfully request the Examiner to reconsider and withdraw all outstanding grounds of rejection. Applicants respectfully request allowance of the application.

Rejection under 35 U.S.C. § 103

The Office Action rejects under 35 U.S.C. 103(a) claim 41 as being unpatentable over Florin et al., U.S. Patent No. 5,621,456 (hereinafter *Florin*) in view of Handelsman, U.S. Patent No. 5,715,315 (hereinafter *Handelman*). The Office Action rejects under 35 U.S.C. 103(a) claim 1-6, 16-21, 27-29, 31-40 and 42 as being unpatentable over *Florin* and *Handelman*, and further in view of Hedger, J., Broadcast Telesoftware: Experience with Oracle (hereinafter *Hedger*). The Office Action rejects claims 7-10, 12-14, and 22-25 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,003,591 to Kauffman (hereafter *Kauffman*) in view of U.S. Patent No. 5,223,924 to Strubbe (hereafter *Strubbe*) and *Hedger*. The Office Action rejects claims 11, and 26 under 35 U.S.C. §103 (a) as being unpatentable over *Kauffman*, *Strubbe* and *Hedger*, in view of U.S. Patent No. 5,561,709 to Remillard (hereinafter *Remillard*). Applicants respectfully traverse the rejection.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, finally the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP, Section 706.02 (j).

Applicants respectfully submit that the Office Action does not establish a prima facie case of obviousness with respect to the pending claims.

With respect to independent claim 41, claim 41 provides a removably connected hardware upgrade card for enhancing the functionality of a set top converter in a television program delivery system. Claim 41 recites, among other features “an interface for providing an electrical connection to the set top converter, whereby the electronic mail is transferred from the set top converter for processing and the processed electronic mail is passed to the set top

converter for display...at least one microprocessor connected to said memory and connected to said interface for accessing the stored interactive programming instructions and for processing the electronic mail to produce processed electronic mail based on the stored interactive programming instructions, wherein said hardware upgrade card is removably connected to said set top converter.”

As agreed to by the Examiner during the interview of November 21, 2003 (*See* attached Interview Summary), neither *Florin* nor *Handelman*, either applied separately or in combination, disclose or suggest a hardware upgrade card for enhancing the functionality of a set top converter as recited in independent claim 41.

As stated in the Office Action at paragraph 4, *Florin* does not discuss any details related to processing of the e-mail services. These details include providing an interface for an electrical connection to the set top box (STB) for processing e-mail and passing the processed e-mail to the STB. *See* Office Action, paper no. 23, at p. 3. The Office Action cites *Handelman* to overcome this deficiency in *Florin*.

However, *Handelman* does not cure the deficiency in *Florin*. *Handelman* also fails to disclose or suggest the recited hardware upgrade card for enhancing the functionality of a set top converter. As disclosed in *Handelman*, a CATV system 10 includes a plurality of subscriber units 14 that include a television 16 and a CATV interface unit 18. *See Handelman*, Fig. 1 and col. 4, lines 51-62. The Office Action equates the CATV interface 18 to the set top converter of the Applicants’ application. As shown in Fig. 2 of *Handelman*, the CATV interface 18 itself includes, for example, the processor 34, the receiver unit 30, controller 40, memory unit 36, on-screen-display (OSD) unit 44 to process the information received via the communication link 12. *See Id.*, col. 6, lines 16-51.

However, *Handelman* does not disclose or suggest a removably connected hardware upgrade card for enhancing the functionality of a set top converter in a television program delivery system as recited in, for example, independent claim 41. For example, *Handelman* does not disclose or suggest, an upgrade card which includes an interface for providing a connection to the set top converter for processing e-mail from the set top converter and for passing to the set top converter processed e-mail for display as recited in claim 41, among other features. Applicant respectfully submit that the external memory unit 38 in *Handelman* does not process e-mail from the set top converter and pass to the set top converter processed e-mail for display as

recited in claim 41. Moreover, the upgrade card includes a memory, and microprocessor for accessing the stored interactive programming instructions and for processing the electronic mail to produce processed electronic mail based on the stored interactive programming instructions. *Handelman* also does not disclose or suggest these features of independent claim 41.

In addition, the applied references, either separately or in combination, do not disclose or suggest “a memory for storing interactive programming instructions that enable a subscriber to engage in textual interactivity with online applications” as recited, among other features, in claim 41.

Moreover, the MPEP clearly states that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The Office Action states that *Florin* does not discuss any details of processing the e-mail services such an interface for an electrical connection to the set top box (STB). However, the Office Action combines *Handelman* with *Florin* for the desirable advantage of making more memory available through the external memory unit. *See* Office Action, p. 3. However, adding more memory (i.e., external memory) as the Office Action states does not address the deficiency of *Florin* which fails to discuss the details of processing the e-mail services. Therefore, there is no motivation to combine *Florin* with *Handelman*.

Moreover, since the Office Action states that *Florin* does not discuss any details of processing the e-mail services such an interface for an electrical connection to the set top box (STB), how would one of ordinary skill in the art be motivated to modify *Florin* or to combine it with *Handelman* to achieve the claimed invention?

Applicants respectfully submit that the Office Action fails to show motivation to modify *Florin* with the teachings of *Handelman*. Therefore, since there is no motivation to combine found in the references themselves, the combination of *Florin* and *Handelman* is improper. Additionally, even if the references were properly combinable, the combination does not overcome the deficiencies of the references described above.

Applicants respectfully submit that the Office Action does not establish a prima facie case of obviousness with respect to claim 41, for example. Therefore, for at least the reasons stated above, independent claim 41 is in condition for allowance over the applied art.

Applicants further submit that claim 42 is patentable over *Florin* and *Handelman* because it depends from independent claim 41 and because it recites additional independently patentable subject matter, *i.e.*, the interactive programming instructions that enable the subscriber to engage in textual interactivity with online applications.

With respect to the rejections of claims 1-6, 16-21, 27-29, and 31-40 as being unpatentable over *Florin*, *Handelman*, *Hedger*, Applicants respond as follows.

Independent claim 1 recites a hardware upgrade for enhancing the functionality of a set top converter which includes, among other features, “an interface for providing an electrical connection to the set top converter, whereby the electronic mail is transferred from the set top converter for processing and the processed electronic mail is passed to the set top converter for display...a memory for storing interactive programming instructions that enable a subscriber to engage in textual interactivity with online applications.”

Applicants respectfully submit that the combination of *Florin*, *Handelman* and *Hedger* does not disclose or suggest at least “a memory for storing interactive programming instructions that enable a subscriber to engage in textual interactivity with online applications.” The Office Action at page 5, paragraph 5 states that *Florin* does not disclose the feature of textual interactivity with online applications, but cites *Hedger* to overcome this deficiency of the applied references. However, *Hedger* also fails to overcome this stated deficiency of *Florin*.

Hedger relates to a teletext decoder that is capable of receiving software from teletext transmissions. *See Hedger*, p. 413. As further described in *Hedger*, the system provides a transmission medium for text, simple graphics and computer software programs. *See Id.*, p. 414. Therefore, *Hedger* discloses a teletext system that is capable of providing one-way data to a user. However, *Hedger* does not disclose or suggest interactive programming instructions that enable a subscriber to engage in textual interactivity with online applications as recited in independent claim 1, for example. In fact, *Hedger* teaches away from engaging in textual interactivity with online applications. *Hedger* states that a distinct advantage of the broadcast telesoftware approach is that the user is afforded total security with respect to the data he might input during the course of a program run. Since the terminal has clearly no means of communicating such data to the outside world, the user can have total privacy assured (emphasis added). *See Id.*, pp. 422-423, sec. 4.1. If *Hedger* does not contemplate communicating data with the outside world, *Hedger* cannot disclose or suggest interactive programming instructions that enable a subscriber

to engage in textual interactivity with online applications as recited in independent claim 1, for example.

As described above with respect to independent claim 41, the Office Action does not provide proper motivation to combine *Florin* with *Handelman*. For example, as described above, adding more memory (i.e., external memory) as the Office Action states does not address the deficiency of *Florin* which fails to discuss the details of processing the e-mail services. In addition, since the Office Action states that *Florin* does not discuss any details of processing the e-mail services such an interface for an electrical connection to the set top box (STB), there exists no motivation to modify *Florin* or to combine it with *Handelman* and now with *Hedger*, as required by the MPEP. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP § 2143.01. Since the Office Action fails to show motivation to modify *Florin* with the teachings of *Handelman* and *Hedger*, the Office Action fails to establish a prima facie case of obviousness with respect to independent claim 1, for example.

Applicants respectfully submit that the Office Action does not establish a prima facie case of obviousness with respect to claim 1. Therefore, for at least the reasons stated above, independent claim 1 is in condition for allowance over the applied art.

With respect to the rejection of independent claim 16, claim 16 recites, among other features “providing an electrical connection between the set top converter and the mailbox, whereby the electronic mail is transferred from the set top converter for processing; storing interactive programming instructions that enable a subscriber to engage in textual interactivity with online applications; accessing the stored interactive programming instructions; and processing the electronic mail to produce processed electronic mail based on the stored interactive programming instructions.” For at least the reasons stated above, Applicants respectfully submit that the applied references do not disclose or suggest these feature of independent claim 16. First, even if properly combinable, the applied references do not disclose or suggest interactive programming instructions that enable a subscriber to engage in textual interactivity with online applications, as claimed. In addition, there exist no motivation in the references themselves to combine and modify the references, as suggested in the Office Action, as described above. Therefore, independent claim 16 is in condition for allowance over the applied art.

With respect to independent claim 27, Applicants respectfully submit that *Florin*, *Handleman*, and *Hedger*, individually or in combination, do not disclose or suggest “receiving electronic mail from the remotely located computer; and integrating the electronic mail into menus; and communicating with on-line databases, interactive services and message services outside of the television program delivery system” as recited, among other features, in independent claim 27. Therefore, independent claim 27 is in condition for allowance over the applied art.

With respect to the rejection of independent claims 31 and 36, claims 31 and 36 recite, among other features “interactive programming instructions that enable a subscriber to engage in textual interactivity with online applications.” As described above in detail, the applied references do not disclose or suggest, for example, this feature of independent claims 31 and 36. Therefore, Applicants respectfully submit that independent claims 31 and 36 are in condition for allowance over the applied art for at least this reason.

If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and MPEP § 2143.03. Applicants respectfully submit that claims 2-6, 17-21, 28-29, 32-35, and 37-40 are allowable because they depend from allowable claims 1, 16, 27, 31, and 36, respectively, and for the additional features they recite. Applicants therefore respectfully request withdrawal of the rejection of claims 2-6, 17-21, 28, 29, 32-35, and 37-40 under 35 U.S.C. § 103 (a).

With respect to the rejections of claims 7-10, 12-14, and 22-25 as being unpatentable over *Kauffman*, *Strubbe* and *Hedger*, Applicants respond as follows.

Kauffman describes a cable television converter with remotely modifiable functionality to receive firmware downloaded over a cable television network. *Kauffman*, however, does not teach or suggest “interactive programming instructions that enable the subscriber to engage in textual interactivity with online applications,” as recited in independent claims 7 and 22.

Strubbe describes a user interface that can access downloaded TV program information, automatically correlate this information with the preferences of the user, create and display at least one program information database based upon the results of the correlation. However, *Strubbe* does not disclose or suggest “interactive programming instructions that enable the subscriber to engage in textual interactivity with online applications.” Therefore, *Strubbe* does not cure the deficiency in *Kauffman*.

As described above, *Hedger* does not disclose or suggest, “interactive programming instructions that enable the subscriber to engage in textual interactivity with online applications,” as recited in independent claims 7 and 22. Therefore, *Hedger* does not cure the deficiency in *Strubbe* and *Kauffman*, as described above.

Accordingly, Applicants respectfully submit that *Kauffman*, *Strubbe*, and *Hedger*, individually or in combination, do not render claims 7 and 22 obvious to one skilled in the art. Therefore, independent claims 7 and 22 are in condition for allowance over the applied art.

With respect to independent claim 12, Applicants respectfully submit that *Kauffman*, *Strubbe*, and *Hedger*, individually or in combination, do not disclose or suggest “a hardware upgrade comprising a telephone modem, connected to the menu generator adapted to provide communications capability with on-line databases, interactive services and message services” as recited, among other features, in independent claim 12. Accordingly, Applicants respectfully submit that claim 12 is not rendered obvious by *Kauffman*, *Strubbe*, and *Hedger*. Therefore, independent claim 12 is in condition for allowance over the applied art.

Applicants further submit that claims 8-10, 13-14, and 23-25 are allowable because they depend from allowable claims 7, 12, and 22, respectively, and for the additional features they recite. Withdrawal of the rejection under 35 U.S.C. §103 (a) is respectfully requested.

With regard to claims 11 and 26, Applicants respectfully traverse the rejection. Claims 11 and 26 depend from independent claims 7 and 22, respectively, and further comprise a telephone modem (claim 11) or communicating with other services outside of the television program delivery system (claim 26). As discussed earlier, independent claims 7 and 22 are patentable over *Kauffman*, *Strubbe*, and *Hedger* because *Kauffman*, *Strubbe*, and *Hedger*, individually or in combination, do not teach or suggest “interactive programming instructions that enable the subscriber to engage in textual interactivity with online applications.” Since *Remillard* does not disclose or suggest “interactive programming instructions that enable the subscriber to engage in textual interactivity with online applications,” *Remillard* does not overcome the deficiencies of *Kauffman*, *Strubbe*, and *Hedger*. Accordingly, Applicants respectfully submit that *Remillard* does not render claims 7 and 22 obvious in view of *Kauffman*, *Strubbe*, and *Hedger*. Applicants further submit that claims 11 and 26 are allowable because they depend from allowable claims 7 and 22, respectively, and for the additional features they recite. Withdrawal of the rejection under 35 U.S.C. §103 (a) is respectfully requested.

CONCLUSION

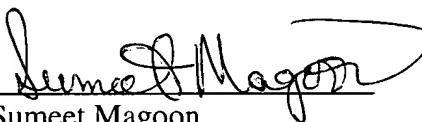
For at least the reasons set forth above, Applicants respectfully submit that this application is in condition for allowance. Favorable consideration and prompt allowance of the claims are earnestly solicited.

It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to our Account No. 50-2849.

Should the Examiner believe that anything further is desired in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

Date: **August 12, 2004**



Sumeet Magoon
Registration No. 43,769
ANDREWS KURTH LLP
1701 Pennsylvania Ave, N.W.
Suite 300 South
Washington, DC 20006
Tel. (202) 662-3053
Fax (202) 662-2739

Attachment: Interview Summary of 11/21/03